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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

HBO-20 CON2
(11664-0004-999)

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Signature _____

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Application Number

10/039,855

Filed

October 19, 2001

First Named Inventor

John K. Billock et al.

Art Unit

2623

Examiner

Annan Q. Shang

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

attorney or agent of record. **40,210**
Registration number _____

attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____



Signature

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February 9, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

*Total of **1** forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
PATENT APPLICATION

Applicants:	John K. Billock et al.	Confirmation No.:	1770
Application No.:	10/039,855	Art Unit:	2623
Filed:	October 19, 2001	Examiner:	Annan Q. Shang
For:	VIDEO-ON-DEMAND SERVICE WITH AN INTERACTIVE INTERFACE FOR FACILITATING VIEWER SELECTION OF VIDEO PROGRAMS	Attorney Docket:	HBO-20 CON2 (11664-0004-999)

New York, New York 10017
February 9, 2007

Mail Stop AF
Hon. Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REMARKS FOR PRE-APPEAL BRIEF CONFERENCE

Sir:

Applicants hereby request review of all rejections in the August 10, 2006 final Office Action (“FOA”), because prima facie obviousness has not been established. In particular, there is no motivation, teaching, or suggestion to combine the cited references, and the combined references do not result in applicants’ invention.

Status of Claims

Claims 1-38 are pending in this application.

All independent claims (1, 7, 10, 14, 16, 19, 21, and 36) stand rejected under 35 U.S.C. § 103(a) as being obvious from Garfinkle U.S. Patent No. 5,530,754 (“Garfinkle”) in view of Callais et al. U.S. Patent No. 3,790,700 (“Callais”).

All dependent claims stand rejected under 35 U.S.C. § 103(a) as being obvious from either Garfinkle and Callais or Garfinkle, Callais, and another reference.

Applicants' Invention

Applicants' claims define video-on-demand (VOD) services and methods of operating VOD services that are accessible by subscribers and non-subscribers of those services. In particular, non-subscribers may view segments/preview of full-length video programs, but not the full-length programs themselves, which only subscribers may view.

The Garfinkle and Callais References

Garfinkle is directed to a VOD system that allows all users to view previews and order video products (*see* column 1, lines 58-62). Garfinkle does not distinguish between subscribers and non-subscribers. In fact, those words are never mentioned in Garfinkle.

Callais is directed to controlling "the availability of programs for CATV subscriber viewing" (column 2, lines 53-54; emphasis added). Callais discloses four modes of operation, all pertaining to subscribers, and does not disclose or suggest in any way what access, if any, a non-subscriber has to CATV programs.

The Examiner specifically cited Callais' second mode of operation, which restricts access to certain programs that are presumably of interest to only certain groups of subscribers. That is, a subscriber is only allowed to view a "restricted" program if that subscriber is on a "restricted list of persons authorized to receive the requested program. Restricted lists ... may be ... composed of groups of doctors, groups of lawyers, or other groups of subscribers sharing a common interest" (column 5, lines 60-64). Thus, according to Callais, a subscriber in a lawyer group may view restricted programs directed to legal strategies, but not to medical or law enforcement topics unless that subscriber is also in those groups.

In Callais' first, third, and fourth modes of operation, subscribers may also view system-determined previews during system-determined preview windows (*see* column 5,

lines 4-10), non-restricted subscription programs (*see* column 6, lines 18-20), and non-subscription programs (*see id.* at lines 49-55).

The Examiner concluded that “it would have been obvious ... to incorporate the teaching of Callais into the system of Garfinkle to ... advertise[] products/services to users, but only provide[] services to previously authorized subscribers and prevent[] transmission of video programs to non-subscribers, in order to force non-subscribers to subscribe to TV programs before receiving services” (FOA, page 5).

No Motivation, Teaching, or Suggestion to Combine Garfinkle and Callais

Garfinkle’s users are billed for each video product they order (*see* column 4, lines 59-65). Thus, there is no reason to identify Garfinkle’s users as subscribers or non-subscribers. Furthermore, there is no reason to restrict the sales of some of Garfinkle’s video products to only certain groups of users as taught by Callais, because doing so would unnecessarily limit the sales of those video products (e.g., a user not in the doctor group may want to order a medical video). Applicants therefore submit that a person of ordinary skill in the art would not be motivated to modify Garfinkle with Callais -- thus allowing Garfinkle’s video products to remain available to as many users as possible.

The Combination of Garfinkle and Callais Does Not Result in Applicants’ Invention

Neither Garfinkle nor Callais discloses or suggests anything with respect to non-subscribers of a VOD service. Furthermore, if Garfinkle were modified in accordance with Callais’ second mode of operation, the resulting modified system would restrict the ordering of some video products to only those users belonging to an appropriate user group. This is not applicants’ invention.

Independent Claim 10

For example, independent claim 10 requires, among other things, “displaying on said display an offer for one of said non-subscribers to become a subscriber substantially immediately after said non-subscriber selects one of said video programs for display.”

Neither Garfinkle nor Callais discloses or suggests this claim limitation.

The Examiner acknowledged that Garfinkle “fails to explicitly teach displaying on a display an offer for the non-subscriber to become a subscriber” (FOA, page 6).

The Examiner then said that if Callais “finds the terminal address of the subscriber on its restricted authorized view list for that type of program, it will … allow the Subscriber to receive the restricted program” (FOA, page 6).

The Examiner then concluded that “it would have been obvious … to incorporate … Callais into … Garfinkle to provide offers to non-subscribers thereby forcing non-subscribers to subscribe to TV programs before receiving services to generate income” (FOA, page 7).

Callais does not in anyway disclose or suggest displaying an offer to a non-subscriber to become a subscriber.

The Examiner further said in the January 8, 2007 Advisory Action that Callais “teaches that, a user of a different group can receive restricted programs from a different group, if some conditions are met, and can instantly modify a user’s profile if they meet these conditions to enable them to receive the restricted programs from other groups.”

Applicants have found no such disclosure in Callais. To the contrary, Callais states “if the subscriber’s terminal address is not on the computer’s authorized viewer list, no video enable command is sent Under this mode of operation therefore, only previously authorized persons can receive restricted category programs” (column 6, lines 12-16).

Other Independent Claims

Garfinkle's system modified in accordance with Callais' second mode of operation also does not result in applicants' invention as defined in the other independent claims. For example, the following claim limitations are not met by the modified system:

“transmitting one of said segments to … a non-subscriber;”

“preventing transmission of one of said video programs to … said non-subscriber[]; and”

“transmitting one of said video programs to … said subscriber[]” (independent claim 1);

“a … computer that allows … said previews to be transmitted to subscribers and non-subscribers of said service and that allows said video programs to be transmitted to only said subscribers” (independent claim 7);

“a first computer programmed to allow … said previews to be transmitted to subscribers and non-subscribers … and to allow said video programs to be transmitted to only said subscribers” (independent claim 14); and

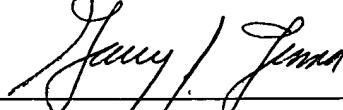
“displaying on said display any of said segments selected … by one of said non-subscribers;”

“preventing display … of said video programs selected … by one of said non-subscribers” (independent claim 16).

Conclusion

There is no motivation, teaching, or suggestion to combine Garfinkle and Callais, and even if combined, applicants' invention as defined in claims 1-38 is not obvious from that combination. Claims 1-38 should therefore be allowable.

Respectfully submitted,



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